

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

OCT 24 2006

U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUY TCHAO

Application No. 09/472,490

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences on October 3, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below:

A review of the file indicates that on May 19, 2005, appellant filed an Appeal Brief under the rules set forth in 37 CFR § 1.192(c). However, the rules under 35 U.S.C. § 1.192(c) were abolished on September 13, 2004, and replaced by 37 CFR § 41.37(c). Moreover, on June 14, 2006, the examiner entered an Examiner's Answer in response to appellant's Brief filed on May 19, 2005. On

July 31, 2006, appellant filed both a Request for Oral Hearing and a Reply Brief in response to the Examiner's Answer mailed on June 14, 2006.

On page 2 of appellant's Reply Brief, appellant states:

As a result of changes in the rules of practice relating to appeal briefs, the original brief did not include an Evidence Appendix or a Related Proceedings Appendix. In order to rectify this omission, submitted herewith is an Evidence Appendix and a Related Proceedings Appendix in accordance with 37 C.F.R. § 41.37.

However, a review of the Appeal Brief filed on May 19, 2005 reveals that the Brief is still not in compliance with the new rules under 37 CFR § 41.37(c).

37 CFR § 41.37(c) states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each claim involved in the appeal, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set

forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone.

Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner.

Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

A review of the application reveals that the following sections are missing from the Appeal Brief filed May 19, 2005:

(1) "Summary of claimed subject matter" as set forth in 37 CFR

§ 41.37(c)(1)(v);

(2) "Grounds of rejection to be reviewed on appeal" as set forth in 37 CFR

§ 41.37(c)(1)(vi);

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- (3) "Evidence appendix," as set forth in 37 CFR § 41.37(c)(1)(ix) (submitted in Reply Brief filed July 31, 2006); and
- (4) "Related proceedings appendix," as set forth in 37 CFR § 41.37(c)(1)(x) (submitted in Reply Brief filed July 31, 2006).

It is required that appellants submit a substitute Appeal Brief that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Moreover, on December 23, 1999, appellant filed an Information Disclosure Statement (IDS). It is not clear from the record whether the examiner considered the statement submitted or whether the examiner notified appellants of why their submission did not meet the criteria set forth in 37 CFR §§ 1.97 and 1.98.

Accordingly, it is

ORDERED that the application is returned to the examiner to:

- (1) hold the Appeal Brief filed on May 19, 2005 defective;
- (2) notify appellant to file a substitute Appeal Brief in compliance with 37 CFR § 41.37;

- (3) to consider appellant's substitute Appeal Brief, and to vacate the Examiner's Answer mailed on December 28, 2005, if required, to respond to appellants' substitute Appeal Brief;
- (4) to consider appellant's IDS filed on December 23, 1999, and to notify appellant in writing as to consideration; and
- (5) for such further action as may be appropriate.

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